

ATTACHMENT - REMARKS

By this Amendment, independent claims 52 and 130 have been slightly amended for clarity. Other dependent claims 5, 7, 11 have also been amended for clarity. Finally, withdrawn claims 101-129 have been canceled to place the application in better condition for allowance. It is submitted that the present application is in condition for allowance for the following reasons.

In the *Examiner's Remarks/Amendments* section of the DETAILED ACTION, the examiner has initially asserted an issue with claim "103". It is assumed, since claim 103 is withdrawn and includes no similar recitation, that the examiner meant independent claim 130 (here as well as at other locations in the Action). Thus, with regard to claim 130, the word "if" is not used to provide "optional language" as would be readily apparent to those of ordinary skill, but rather to indicate that a method step takes place upon the occurrence of the noted determination. Such language is routinely used by those of ordinary skill, and in US patent claims. However, to emphasize the difference, the term "if" has been changed to "whether" there is a "match", and then "where there is a match" communicating the match to the transaction manager.

With regard to dependent claim 7, the examiner asserts that the phrase "module is operable to authenticate the terminal in the mobile and/or cellular telecommunication system" is the "result" of the limitation, and hence does not limit the scope of the claim. However, the noted phrase, which has been amended to more clearly show it is a further limitation the recited "card or module" is clearly not the "result" thereof since a card or module by itself does not achieve such a result. Rather, the use of such functional or operative language is specifically sanctioned for use in US claims (see the

lengthy discussion in "Supplementary Examination Guidelines for Determining Compliance With 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications", Federal Register (February 9, 2011), Vol. 76, No. 27, II.A.1.). Briefly, it will be noted in the Guidelines, that functional language is indicated as being **acceptable, except when** the functional claim language is used as "a description of a problem to be solved or a function or result achieved by the invention" (see the 2nd paragraph under § II.A.1.). It is therefore submitted that amended claim 7 is thus certainly definite, particularly when read in conjunction with the specification to provide an understanding of the claim language, and thus that this phrase does further limit the claim in a manner which must be considered.

With regard to dependent claim 5, the examiner indicates that the claim uses "non-functional descriptive material". However, the "predetermined information" as now clearly set forth in the claim is not "non-functional", but clearly functions as the previously recited "predetermined information". Thus, particularly as now amended, this language is functional and does serve to limit the scope of the invention.

The examiner next notes that "claim 56 contains language found in claim 5"; and later that "claim 58 contains similar language found in claim 7". The reason for this notation by the examiner is not given, nor apparent. If this notation by the examiner is supposed to be some allegation of redundant recitations, the examiner should note that the similar claims depend from different independent and method claims, so there is no possibility of redundancy.

At the top of page 4, the examiner also indicated that functional language is given no patentable weight. However, after noting that this assertion is made with

respect to "method claims", the examiner goes on to base this indication on how a "product" is supposed to be defined. Thus, initially, it is apparent that the examiner is misguided in applying comments on structure of an apparatus to the recitations of the steps of a method (which steps, by definition, are functional!): Again, the examiner is directed to the above noted "Guidelines" which clearly show that the asserted functional recitations, especially in a method claim, must be given patentable weight.

With regard to claim 11, this claim has been further revised to clearly show that a method limitation is made and as such must be given patentable weight.

On pages 5-6, the examiner has noted the use of "Official Notice" twice, and the examiner has stated that applicant has "not attempted" to traverse the Official Notice statements so that such statements are treated as being "admitted". However, the examiner has evidently overlooked both instances in the Remarks section of the previous Amendment where applicant has argued against the propriety of the noted uses of Official Notice. In fact, applicant specifically stated "the official notice of this step of applicant's invention is challenged" for the noted reason (see the penultimate paragraph on page 3 and the top of page 4); and that this use of Official Notice is made "in error and should be withdrawn" (see page 4, 2nd ¶). Therefore, the examiner was and again now is required to support this factual assertion with "adequate evidence" (see MPEP § 2144.03.C.).

Next in the *Claim Rejections - 35 USC § 112* [1st Paragraph] section, the examiner has asserted that independent claim 52, and later independent claim "103" (*sic*, 130), as well as the claims dependent therefrom, both recite, e.g., "generate transaction data relating to the transaction" without a basis in the specification as filed.

However, for example, it is indicated at page 3, lines 17-19 of the application that the invention includes:

generating in response to a request, made using data processing apparatus, from a user to a product or service provider a transaction request data packet including data indicative of the identity of the user and the identity of the product or service provider.

Thus, as those of ordinary skill would appreciate, transaction request data in a packet is nonetheless "transaction data" and is it clearly generated. Not only does this data include a user ID, it also includes "data indicative of ... the identity of the product or services provider". A person of ordinary skill would read a requirement to generate such a data packet in the proper context and understand that generation of the data packet is one and the same as generating transaction data as required in the claims. Therefore, it is submitted that this § 112 1st ¶ rejection of independent claims 52 and 130 should be withdrawn, together with the rejection of the claims dependent therefrom for this same reason.

Subsequently in the second *Claim Rejections - 35 USC § 112* [2nd Paragraph] section, the examiner has asserted that independent claim 52, and later independent claim "103" (*sic*, 130), as well as the claims dependent therefrom, both recite the same phrase as noted above in the § 112 1st ¶ rejection, which is now alleged to be unclear and to make the claims indefinite. However, as noted above, the transaction request data packets generated at the quoted paragraph necessarily includes transaction data and this paragraph helpfully explains what that data entails - identity information for both user and service provider. While there is no exhaustive contents list, the person of ordinary skill would read this passage and the surrounding passages to appreciate the bounds of the transaction data - i.e. only such information as would conventionally be

required for such a transaction to be effected such as the identities of the user and of the supplier. Therefore, it is submitted that this § 112 2nd ¶ rejection of independent claims 52 and 130 should also be withdrawn, together with the rejection of the claims dependent therefrom for this same reason.

Also in this 2nd ¶ section, dependent method claim 17 was asserted to be unclear as to “what is actually performing the coupling or how it is being accomplished” and “what is meant by ‘over a carrier’”; and later similarly independent system claim 52 was asserted to be unclear due to the non-use of the “user’s telecommunications terminal”. However, as explained in the present specification, it was not conventional – despite the examiner’s first Official Notice assertion, which has been traversed and thus is not admitted – at the time of the present invention (2003) to assume that the SIM (or other smart card) in a cell phone could be expected to act as authenticator when the SIM was not even coupled to its conventionally assigned terminal. Conventionally, or as appreciated by those of ordinary skill at the time, a SIM card was a smartcard dedicated to a cell phone (or “user’s telecommunications terminal”); while in the present invention, the SIM is removable and can then be used to authenticate a transaction without actually being in the terminal/phone (or without being used with the “user’s telecommunications terminal”). Thus, the present specification makes it clear that a SIM card or the like can be coupled by a user to a carrier separate from the cell phone from which the SIM came. It is therefore submitted that the noted step recited in claim 17 and the apparatus recited in claim 52 are definite, so that the rejections of claims 17 and 52 should now be withdrawn.

Finally, In the *Claim Rejections* - 35 USC § 103 section, independent claims 52 and 130 and various noted claims dependent therefrom were all rejected under 35 USC § 103 as being obvious over Malinen (USPA 2003/0028763 to Malinen et al.) in view of Chappuis (USPA 2003/0171993 to Chappuis). However, for the following reasons, it is submitted that these claims are all allowable over this combination of references.

With respect to both independent claims 52 and 130, the examiner also took "official notice" of the teaching in the prior art of the recitation in claim 52 (and similarly in claim 130) of:

predetermined authentication [SIM] information being stored by each authentication storage devices corresponding to [SIM] information which is used to authenticate a telecommunications terminal of that user in relation to the telecommunications system but the authentication process for authenticating the transaction by that user with the data processing apparatus not requiring use of that user's telecommunications terminal.

This feature of the invention is not disclosed nor made obvious by either Malinen or Chappuis (which is why Official Notice was taken).

The examiner has now stated that the examiner's assertion in the previous Office Action, that such a feature was "common knowledge" so that Official Notice thereof in the prior art was proper, was not traversed by applicant in applicant's previous Response, so that this assertion was now treated by the examiner as being "admitted" by applicant. However, as noted above, applicant most certainly did not make any such admission of this feature being in the prior art. Instead, applicant specifically argued that such a use of Official Notice was improper.

Applicant thus repeats that Official Notice is only proper for a fact, and the assertion that such a fact is common knowledge of those of ordinary skill. However, the above quoted feature is not a fact, and thus this assertion is not entitled to Official

Notice and this assertion is again traversed. Consequently, unless the examiner can establish this assertion with prior art, independent claims 52 and 130 are not disclosed or made obvious by a combination of Malinen or Chappuis, so that these claims are both allowable over this combination of references. Similarly, all of the remaining pending claims are ultimately dependent from one of these two independent claims and thus the remaining pending claims are allowable at least for the same reasons that the independent claims are allowable.

For all of the foregoing reasons, it is submitted that the present application is in condition for allowance and such action is solicited.

Respectfully submitted,

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